

Attorney Docket: 052775-0311431

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE PATENT : David SCHMIDT
APPLICATION OF
SERIAL NO. : 10/669,596
FILING DATE : September 25, 2003
ART UNIT : 1611
EXAMINER : ISIS A. D. GHALI
FOR : BIOMOLECULAR WEARABLE DEVICE

REQUEST FOR PRE-APPEAL BRIEF REVIEW

Mail Stop AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action mailed **August 19, 2008** ("the Office Action"), Appellant hereby requests that a panel of examiners formally review the legal and factual basis of the rejections in the above-identified application prior to the filing of an appeal brief. This request is being concurrently filed with a Notice of Appeal. The review is requested for the reasons provided below.

Appealed Rejection

Claims 1, 3, 5, 6, 10, 11, 14, 16, 18, 20, 22, 24, 38, 42, 58, and 59 currently stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,475,514 to Blitzer *et al.* ("Blitzer"); claim 26 currently stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Blitzer in view of U.S. Patent No. 6,558,695 to Moo-Young *et al.* ("Moo-Young"); and claim 34 currently stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Blitzer in view of U.S. Patent No. 6,558,695 to Luo *et al.* ("Luo"). Each of these rejections is appealed.

Arguments for Traversal

Simply put, the invention relates to a wearable device having an organic material.

The device contains the organic material within an enclosure such that the organic material is prevented from contacting a subject's body, **even during use** (e.g., the device is non-transdermal). In stark contrast, the primary reference relied on by the Examiner (Blitzer) is indisputably a transdermal patch that delivers an organic material into the body of a user through the skin. For at least this reason the rejections must be reversed.

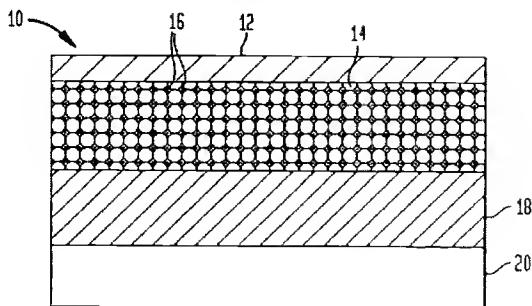
I. **Claim 1 And Its Dependent Claims.**

The rejection of claims 1, 3, 5, 6, 10, 11, 14, 16, 18, 20, 22, 24, 38, and 42 constitutes clear legal error at least because the Examiner has failed to demonstrate that Blitzer discloses all of the features of the claimed invention, and in fact contradicts the invention, thus teaching away therefrom. For example, claim 1 recites the following features, which are not disclosed in the sections of Blitzer relied on by the Examiner:

...at least one enclosure for enclosing said at least one organic material and said at least one substrate, wherein said at least one enclosure comprises an adhesive for adhering said at least one enclosure to said subject's body and wherein said at least one enclosure **prevents said at least one organic material from direct contact with said subject's body while said at least one enclosure is adhered to said subject's body using said adhesive.**

Generally, Blitzer discloses a transdermal patch that delivers nutrients into the blood stream of the body through the epidermis. See, e.g., Blitzer, c. 2, II. 25-34. Blitzer discloses a specific embodiment, shown in FIG. 1 (reproduced below) in which an athletic supplement is carried in a polymer matrix 16. See, e.g., Blitzer, c. 18, II. 26-36. The polymer matrix 16 is bounded on one side by a pressure sensitive adhesive layer 18 and a release liner 20, and on the other side by a medical grade adhesive 14 and a backing layer 12. See, e.g., Blitzer, c. 17, I. 66-c. 18, I. 26. In use, backing layer 12 is removed from the patch to expose adhesive 14, which secures the polymer matrix 16 to the skin of the user. See, e.g., Blitzer, c. 18, I. 65-c. 19, I. 6. Adhesive 14 and polymer matrix 16 are configured such that upon application of the patch to the skin of the user, the athletic supplement carried in polymer matrix 16 is released into the skin. See, e.g., Blitzer c. 9, II. 64 and 65.

FIG. 1



In rejecting claim 1, the Examiner alleges that the athletic supplement disclosed in Blitzer can be interpreted as the “at least one organic material” of claim 1, and that polymer matrix 16 and the adhesive 14 can be interpreted as the “at least one enclosure of claim 1.” The Office Action, p. 5. Polymer matrix 16 and adhesive 14 are expressly disclosed in Blitzer as releasing the athletic supplement into the skin of the user when adhesive 14 is bonded to the skin. See, e.g., Blitzer c. 9, II. 64 and 65. In fact, the Examiner has acknowledged that the patch disclosed in Blitzer is a “*transdermal* patch for administration of [sic] nutrient supplement to a subject.” The Office Action, p. 3. As such, the disclosure of Blitzer and the *express admissions of the Examiner* both indicate that athletic supplement is released from polymer matrix 16 into the skin of the user. The athletic supplement thus makes “direct contact” with the skin of the user and passes through it. Therefore, polymer matrix 16 and adhesive 14 do not “**prevent[] said at least one organic material from direct contact with said subject's body while said at least one enclosure is adhered to said subject's body using said adhesive.**” For at least this reason the rejection of claim 1 based on the cited sections of Blitzer constitutes a clear legal error and must be overturned.

Claims 3, 5, 6, 10, 11, 14, 16, 18, 20, 22, 24, 38, and 42 depend from claim 1. As such, the rejection of claims 3, 5, 6, 10, 11, 14, 16, 18, 20, 22, 24, 38, and 42 based on the cited sections of Blitzer constitute clear legal error and must be overturned due to the dependency of claims 3, 5, 6, 10, 11, 14, 16, 18, 20, 22, 24, 38, and 42, as well as for the features that they recite individually.

Claim 26 depends from claim 1. The sections of Moo-Young cited by the Examiner in rejecting claim 26 do not address the deficiencies of Blitzer with respect to

claim 1 set forth above. Therefore, the rejection of claim 26 must be overturned due to its dependency, as well as for the features that it recites individually.

Claim 34 depends from claim 1. The sections of Lue cited by the Examiner in rejecting claim 34 do not address the deficiencies of Blitzer with respect to claim 1 set forth above. Therefore, the rejection of claim 34 must be overturned due to its dependency, as well as for the features that it recites individually.

II. Claim 58

The rejection of claim 58 constitutes clear legal error at least because the Examiner has failed to demonstrate that Blitzer discloses each and every feature of the claimed invention. For example, claim 58 recites *inter alia* the following features, which are not disclosed in the sections of Blitzer relied on by the Examiner:

...at least one enclosure for enclosing said at least one organic material and said at least one substrate, wherein said at least one enclosure prevents said at least one organic material from direct contact with said subject's body and **wherein the beneficial biological effect for the subject is accomplished while said at least one organic material and said substrate are enclosed in said at least one enclosure.**

By the Examiner's admission, Blitzer discloses a transdermal patch that releases an athletic supplement into the bloodstream of a user through the user's skin. The Office Action, pp. 3 and 5. Blitzer claims that the athletic supplement provides a beneficial biological effect, but is clear in disclosing that the athletic supplement does not provide the intended effect unless it is released into the bloodstream. See, e.g., Blitzer, c. 2, ll. 25-34. Therefore, the "beneficial biological effect" of the athletic supplement of Blitzer is **not** "accomplished while [the athletic supplement is] enclosed in said at least one enclosure." For at least this reason the rejection of claim 58 constitutes clear legal error and must be overturned.

III. Claim 59

The rejection of claim 59 constitutes clear legal error at least because the Examiner has failed to demonstrate that Blitzer discloses each and every feature of the claimed invention. For example, claim 59 recites *inter alia* the following features, which

are not disclosed in the sections of Blitzer relied on by the Examiner:

...at least one wearable object comprising at least one enclosure for said at least one organic material and said at least one substrate, wherein said at least one enclosure **prevents said at least one organic material from direct contact with said subject's body while said at least one wearable object is worn on said subject's body.**

As was demonstrated above with respect to claim 1, when the patch of Blitzer is adhered to the body of a user, the patch releases an athletic supplement into the body of the user through the user's skin. This is acknowledged by the Examiner (see the Office Action, p. 3), and is expressly stated in the disclosure of Blitzer (see c. 9, ll. 64 and 65). As such, the patch disclosed in Blitzer does not "**prevent[] said at least one organic material from direct contact with said subject's body while said at least one wearable object is worn on said subject's body.**" For at least this reason the rejection of claim 59 constitutes clear legal error and must be overturned.

CONCLUSION

Therefore, it is respectfully requested that the panel return a decision concurring with Appellant's position that the pending rejection of each of claims 1, 3, 5, 6, 10, 11, 14, 16, 18, 20, 22, 24, 26, 34, 38, 42, 58, and 59 constitutes legal error and should be reversed. Notice to that effect is anticipated.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Date: October 7, 2008 _____ Respectfully submitted,

By:


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